REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 24-52 and 54 are pending in this case. Claims 24, 47, and 54 are amended by the present amendment with support in the originally filed disclosure at least at paragraphs [0066] to [0070] and [0088] to [0090] of the published Specification. Thus, no new matter is added.

In the outstanding Office Action, Claims 24-27, 29, 30, 32-36, 38, 43, 45-50, 52, and 54 were rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi (U.S. Pub. No. 2002/0141380) in view of Levin, et al. (U.S. Pub. No. 2002/0149784, herein "Levin"); Claims 28, 31, 39-42, 44, and 51 were rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi in view of Levin, further in view of Ben-Chorin, et al. (U.S. Patent No. 7,352,488, herein "Ben-Chorin"), and Claim 37 was rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi in view of Levin, further in view of Kajita, et al. (U.S. Patent No. 6,069,706, herein "Kajita").

Applicants respectfully traverse the rejections of pending Claims 24-52 and 54.

Amended Claim 24 requires an image processing apparatus with a printer engine

> a **memory** that **stores** the **image data in a first format following** scanning correction which includes **conversion** from red, green, and blue (RGB) **to** cyan, magenta, yellow, and black **(CMYK)**;
> a **printer engine** that **forms an image** on a recording medium **based on the stored image data in the first format**, without performing additional color conversion, **whenever the printer engine forms the image on the recording medium;**
> a **format converter** that **converts the first format** of the image data stored **to a second format** that is compatible with an external device based on predetermined conditions set in the image processing apparatus;
> a connecting unit that connects with a network, wherein the external device is connected to the network; and

a **transmitter** that **transmits the image data in the
second format** to the external device via the connection unit.

The outstanding Office Action asserts <u>Koguchi</u> as teaching every element of Claim 24

except the memory and the printer engine, which it asserts <u>Levin</u> as teaching.

Specifically, the outstanding Office Action asserts front end image processing 60 at

Fig. 2A of <u>Levin</u> as teaching scanning conversion "which includes conversion from red,

green, and blue (RGB) to cyan, magenta, yellow, and black (CMYK)," as defined by Claim

24 and asserts the printer 90 at Fig. 2B of <u>Levin</u> as teaching a printer engine as defined by

Claim 24.

However, <u>Levin</u> fails to teach "a **printer engine** that **forms an image** on a recording

medium **based on the stored image data in the first format**, without performing additional

color conversion, **whenever the printer engine forms the image on the recording

medium**," as recited by amended Claim 24 and, thus, fails to cure the conceded deficiencies

of <u>Koguchi</u> with regard to the printer engine as defined by Claim 24.

As described at paragraph [0015] of <u>Levin</u> and shown at Figures 2A and 2B of <u>Levin</u>,

the front end image processing 60 is only reached if the size of the original must first be

determined. Thus, in <u>Levin</u>, a copy is printed at process copy 58, which precedes the front

end image processing 60 and, therefore, does not print image data that can be asserted as

being in the first format, or a copy is printed at the printer 90, which follows the front end

image processing 60 and, therefore, does print image data that is asserted as being in the first

format.

However, amended Claim 24 requires that the printer engine "forms an image...based

on the stored image data in the first format...whenever the printer engine forms the image"

rather than some of the times that a print is generated, as in <u>Levin</u>.

Further, the outstanding Office Action did not respond to the arguments in the previous response that <u>Koguchi</u> and <u>Levin</u> are not properly combined and do not establish a *prima facie* case of obviousness.

The outstanding Office Action asserts <u>Levin</u> as teaching scanning correction which includes conversion to the first format, as defined by Claim 24, and asserts <u>Koguchi</u> as teaching a format converter that converts the first format to the second format. By the assertions in the outstanding Office itself, neither <u>Levin</u> nor <u>Koguchi</u> teaches two conversions, one to a first format and another from the first format to the second format. Instead, the conversion done in <u>Levin</u> is proposed to be added to <u>Koguchi</u> "to prepare data for printing," as asserted at page 4 of the outstanding Office Action.

However, the outstanding Office Action offers no rational underpinnings for why one of ordinary skill would be motivated to add a separate conversion process from <u>Levin</u> to <u>Koguchi</u> for printing, rather than simply select a conversion format, in the existing process of <u>Koguchi</u>, that is suitable to printing.

As noted in the previous response, the Court recently reiterated the requirement for asserting a proper motivation under MPEP § 2143.01 by stating that a "patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." <u>KSR Int. Co. v. Teleflex Inc.</u>, 82 USPQ2d 1385, 1389 (2007). The Court noted, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006)), "there must be some articulated reasoning with some <u>rational underpinning</u> to support the legal conclusion of obviousness" (emphasis added).

If a rejection of Claim 24 is maintained based on a combination of <u>Koguchi</u> and <u>Levin</u>, Applicants request that all of the above arguments be specifically addressed, including the arguments regarding the impropriety of combining <u>Koguchi</u> and <u>Levin</u>.

Because Koguchi and Levin are not properly combined and because, even in combination, Koguchi and Levin fail to teach or suggest at least the above-discussed features of amended Claim 24, Applicants respectfully request that the rejection of Claim 24 under 35 U.S.C. § 103(a) be withdrawn.

Claims 47 and 54, though differing in statutory class and scope from Claim 24, patentably define over the combination of Koguchi and Levin for reasons similar to those discussed above with regard to Claim 24. Thus, Applicants respectfully request that the rejection of Claims 47 and 54 under 35 U.S.C. § 103(a) be withdrawn.
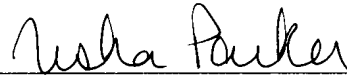
Claims 25-46 depend from Claim 24, and Claims 48-52 depend from Claim 47. Thus, Claims 25-46 and 48-52 patentably define over the combination of Koguchi and Levin for at least the same reasons as Claims 24 and 47. Further, Ben-Chorin, which is additionally asserted against Claims 28, 31, 39-42, 44, and 51, and Kajita, which is additionally asserted against Claim 37, do not cure the deficiencies of the combination of Koguchi and Levin with regard to Claims 24 and 47 and, further, are not asserted for the above-discussed features that are deficient in the combination of Koguchi and Levin.

Thus, Applicants respectfully request that the rejections of Claims 25-46 and 48-52 under 35 U.S.C. § 103(a) be withdrawn.

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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